

Application No. 09/901,979  
Applicant(s): Lutz Heuer et al.  
Amendment in Response to Office Action dated November 12, 2003

### REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 9, 11, 12 and -15 are pending. Claims 7, 8, 10, 13 and 14 have been canceled. The subject matter contained in canceled claim 10 has been incorporated into claim 15. Amendments have been made to claims 9, 11, and 12 to correct a dependency issue. Amendments have been made to claim 15 to overcome the rejections under 35 U.S.C. 102 and 35 U.S.C. 103. Changes that have been made to the claims using strikethrough and underlining are presented above. It is believed that no new matter has been added.

### Rejections under 35 U.S.C. 102

The Examiner rejected claims 7, 9, and 15 under 35 U.S.C. 102(b) as being anticipated by Schaub (U.S. Patent No. 4,664,696). The Examiner found Schaub teaches a fungicidal composition comprising cyproconazole plus another fungicide such as benzimidazole (benomyl).

In response, Applicants have canceled claim 7 and incorporated into claim 15 the subject matter of claim 10, which was not rejected under this section of the statute. Claim 9 has been amended to depend upon claim 15.

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In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Rejections under 35 U.S.C. 103

The Examiner rejected claims 10 and 11 under 35 U.S.C. 103(a) as being obvious over Schaub as applied to claims 7, 9, and 15 in further view of Valcke et al. Schaub, as discussed above, was found by the Examiner to teach a composition comprising cyproconazole. The Examiner further found Valcke to teach a composition comprising propiconazole. The Examiner conceded Schaub contains no suggestion for propiconazole. Nevertheless, the Examiner found it would have been obvious to modify the composition in Schaub to include propiconazole to yield the instantly claimed composition, and to make the composition in Schaub more effective in controlling fungi on wood.

In response to the Examiner's rejection, Applicants point out that the thrust of the rejection is directly rebutted by the evidence already of record. Specifically, the Declaration of Dr. Martin Kugler dated April 24, 2002, which is of the record and filed with Applicants' response on July 18, 2001, already shows that the combination of cyproconazole and propiconazole leads to a synergistic result, which synergistic result is completely unexpected in view of the cited prior art of record. An additive effect, as the Examiner's proposed combination would suggest, would have resulted in a value of X equal to 1. Clearly the data do not support this contention. "Test 1" at page 2 of the Declaration shows that when cyproconazole and propiconazole are combined,

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they achieve a synergistic effect as indicated by the value of 'X' equal to 0.67. Applicants submit this data directly rebuts the allegation that combining cyproconazole and propiconazole would have been obvious. Consequently, this rejection should be reconsidered and withdrawn on this basis alone.

Applicants would also point out that the claims require the improvement which is demonstrated, i.e., that the combination of cyproconazole and the second ingredient is synergistic. Consequently, the claims are exactly commensurate in scope with the improvement.

Less there be any doubt that the improvement is realized with other combinations, Applicants point out that the data in the Declaration additionally supports the claimed *synergistic* effect between cyproconazole and a second ingredient other than cyproconazole. Thus the data shows similar benefits with other claimed combinations, wherein "Test 2" at page 3 shows a synergistic effect when cyproconazole and tebuconazole are combined, as indicated by the value of 'X' equal to 0.73. Thus, the data support a finding of unexpected and/or surprising results, whereby the claims as a whole are nonobvious by the combination of the cited references. See MPEP §716.02.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

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Conclusion

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (8 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: May 12, 2004

By David D. Kim  
David D. Kim